The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD F. DEPALMA,
CLIFFORD J. DWYER, and ROBERT P. LETENDRE

Appeal 2007-2413
Application 10/041,117
Technology Center 3700

Decided: June 28, 2007

Before DEMETRA J. MILLS, LORA M. GREEN, and NANCY J. LINCK, *Administrative Patent Judges.*

GREEN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 6, 20, 21, and 24. We have jurisdiction under 35 U.S.C. § 6(b). Claim 1 is representative of the claims on appeal, and reads as follows:

1. A system for bypassing an aneurysm, comprising:

a first prosthesis, defining a single flow channel conduit, having a proximal end and a distal end, including a self-expanding lattice and graft material covering at least a portion of the self-expanding lattice, the graft material having longitudinally oriented pleats, the first prosthesis being configured to expand an artery into which it is positioned and anchor and seal the system within the artery;

a compressible gasket positioned within the distal end of the first prosthesis, the compressible gasket comprising at least two apertures therein; and

at least two bypass prostheses in fluid communication with the first prosthesis via the distal end of the first prosthesis, the at least two bypass prostheses having proximal and distal ends, wherein the distal ends of the at least two bypass prostheses are configured to anchor the at least two bypass prostheses downstream of the aneurysm and the proximal ends of the at least two bypass prostheses are configured to pass through the at least two apertures in the compressible gasket positioned in the distal end of the first prosthesis such that fluid flow paths are established, the compressible gasket being configured to engage and seal the at least two bypass prostheses to the first prosthesis.

The Examiner relies on the following art:

Rhodes	US 5,843,160	Dec. 1, 1998.
Lunn	US 5,476,506	Dec. 19, 1995.
Dereume	US 6,554,858 B2	Apr. 29, 2003.

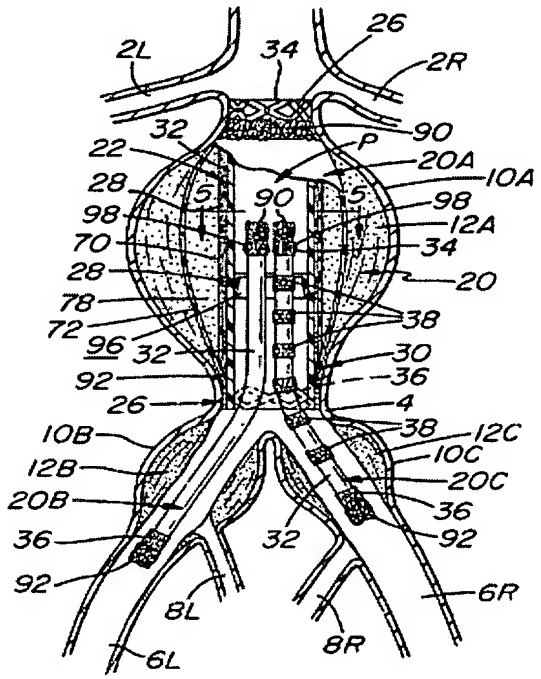
Claims 1, 6, 21, and 24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Rhodes. Claim 20 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Rhodes. Finally, claims 1, 6, 20, 21, and 24 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Dereume and Lunn.

We affirm.

DISCUSSION

Claims 1, 6, 21, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rhodes. As Appellants do not argue the claims separately, we focus our analysis on independent claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner cites the reference numbers of Figure 1 in the rejection. Figure 1 of Rhodes is a front plan illustration of a preferred embodiment of the prosthesis taught by Rhodes and is reproduced below (Rhodes, col. 5, ll. 46-52).

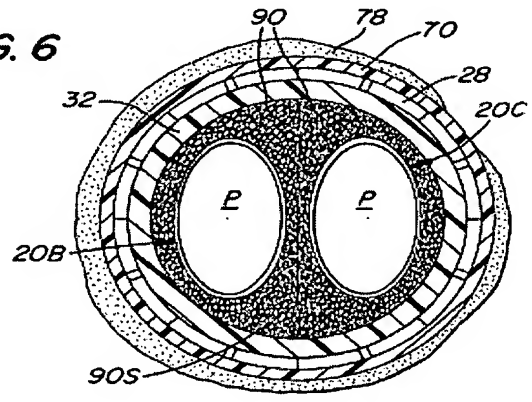


According to the Examiner, Rhodes teaches a system for bypassing an aneurysm, the system having a first prosthesis (**20A**) defining a flow conduit having a proximal (top) end and a distal end, such that the conduit comprises a stent structure (**26, 28**) and a graft (**22**) covering the stent structure

(Answer 3). The graft, or sleeve, includes a plurality of longitudinally extending pleats (Answer 3, citing Rhodes, col. 8, ll. 6-15).

The upper open end of each of the bifurcation sleeves is arranged to be located at a joint within the open bottom end (*i.e.*, the distal end) of the common sleeve (the first prosthesis, (**20A**), and sealing means) (which reads on the gasket of claim 1) is provided between the common sleeve and the two bifurcation sleeves (the two bypass prostheses, (**20B, 20C**)) to prevent blood from leaking from the joint (Rhodes, col. 4, ll. 38-47; *see also* Answer 3). The Examiner cites Figure 6 of Rhodes, which shows a cross-section of the prosthesis at the joint. Figure 6 is reproduced below:

FIG. 6



As set forth by the Examiner, the system of Rhodes includes a compressible gasket (**90S**) positioned within the distal end of the first prosthesis, the gasket having at least two apertures therein (**P**), and at least two bypass prostheses (**20B, 20C**) in fluid communication with the distal end of the first prosthesis (**20A**) through the apertures (Answer 3-4). The gasket or sealing means is thus configured to provide a seal between the first prosthesis and the two bifurcation prostheses (Answer 4).

In order for a prior art reference to serve as an anticipatory reference, it must disclose every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). We agree with the Examiner that Rhodes teaches all of the limitations of claim 1, and the rejection is affirmed.

Appellants argue that "[i]n claim 1, the first prosthesis comprises a self-expanding lattice covered by graft material. In Rhodes, stents are only utilized on the ends of the sleeves and not throughout the entire length of the component." (Br. 4) Thus, according to Appellants, that is one difference between the system of claim 1 and the system disclosed by Rhodes, thus Rhodes cannot anticipate the claimed invention (*id.*).

Appellants' arguments are not convincing. Claim 1 requires "a first prosthesis, defining a single flow channel conduit, having a proximal end and a distal end, *including* a self-expanding lattice and graft material covering at least a portion of the self-expanding lattice." (Claim 1 (emphasis added).) Rhodes teaches a first prosthesis having stent and graft material ,*i.e.*, a self-expanding lattice and graft material covering at least a portion of the self-expanding lattice, at the end of the first prosthesis (**20A**), to anchor the system to the vessel (Rhodes col. 8 ll. 24-65). The transition phrase "including" is synonymous with the transition phrase "comprising," and does not exclude other elements, such as the portions of the first prosthesis of Rhodes not having a stent. Thus, claim 1 does not require that the stent be utilized the entire length of the first prosthesis, and thus the system of Rhodes meets all of the limitations of claim 1.

Appellants argue further, citing *Corning Glass Works v. Sumitomo Electric U.S.A.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989) and

Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc., 45 F.3d 1550, 33 USPQ2d 1469 (Fed. Cir. 1995) for the proposition that the claims should be read in light of the Specification, that "the specification, including the drawings, set forth that the phrase 'self-expanding lattice and graft material covering at least a portion of the self-expanding lattice' means a stent running the length of the graft and not what Rhodes discloses or suggests. In other words, it is clear from the specification what the claims set forth." (Reply Brief, 2-3).

During prosecution, however, claims are given their broadest reasonable interpretation. *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In addition, it is during prosecution that inventors can amend their claims; thus it is during prosecution that any ambiguity in the claim should be clarified. *See, e.g. In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997) ("It is the applicants' burden to precisely define the invention, not the PTO's. See 35 U.S.C. § 112, ¶ 2. . . . [T]his section puts the burden of precise claim drafting squarely on the applicant.").

Claim 1 uses the transition phrase "including" before the phrase "self-expanding lattice and graft material covering at least a portion of the self-expanding lattice," and cannot be interpreted to require that the stent run the length of the graft. Appellants are asking us to read limitations from the Specification into the claims, which we decline to do. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560. 1570-71, 7 USPQ2d 1057, 1064 (Fed. Cir. 1988) (noting that it is the claims, not the specification, that defines the claimed invention, and that embodiments and examples appearing in the specification will generally not be read into the claims).

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being obvious over Rhodes in view of the instant Specification.

Rhodes is relied upon as above (Answer 4). The Examiner states that while Rhodes teaches the use of a gasket, Rhodes teaches that the gasket is made out of mesh, not foam as required by claim 20 (*id.*). According to the Examiner, Appellants admit in the Specification at page 21 "that open cell foams are well known materials for use with gaskets, to those of ordinary skill in the art, and obvious equivalents to the woven and knitted meshes such as the ones disclosed by Rhodes." (Answer 4-5.)

The Examiner concludes that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an open cell foam for the gasket material, since it has been held to be within the general skill of a worker to select a known material on the basis of its suitability for the intended use . . . ." (*Id.* at 5.)

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citations omitted). In order to determine whether a prima facie case of obviousness has been established, we considered the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1996): (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the relevant art; and (4) objective evidence of nonobviousness, if present.

As to this rejection, Appellants argue that "Rhodes fails to disclose the first prosthesis as claimed in claim 1," and that "there is simply no teaching

or suggestion in Rhodes of the first prosthesis of the claimed invention." (Br. 5.) We have already dealt with this argument with respect to the previous rejection, and it is not found to be convincing for the reasons set forth above. Thus, the rejection is affirmed.

Claims 1, 6, 20, 21, and 24 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Dereume and Lunn.

Dereume is cited for teaching "a system substantially as claimed." (Answer 5.) As to the compressible gasket, the Examiner points to portions (**5**) and (**6**) of sleeve (**4**) as seen in Figure 7, or the partitions in Figures 10, 12, and 17 (Answer 5). According to the Examiner, Dereume fails to teach that the graft of the first prosthesis has pleats (*Id.* at 5-6). Lunn is cited to remedy that deficiency. The Examiner concludes that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Dereume's aneurysm bypassing system with stent and graft, with Lunn's teaching of placing longitudinal pleats on the graft of aneurysm bypassing systems, in order to provide the prosthesis with radial flexibility, allowing the graft to expand further." (*Id.* at 6.)

Appellants argue that Dereume teaches a sleeve which has two parts that are affixed to one another to create channels, whereas claim 1 requires a compressible gasket positioned at the distal end of the first prosthesis (Br. 7). We agree with Appellants that the Examiner has failed to establish that the combination of references teaches the compressible gasket as required by claim 1, and we are thus compelled to reverse the rejection.

The Examiner, in relying on Dereume, points to portions (**5**) and (**6**) of sleeve (**4**) as seen in Figure 7, or the partitions in Figures 10, 12, and 17, as being the compressible gasket required by claim 1. Dereume teaches that

"[t]he sleeve **4** has, in its central part, diametrically opposite parts **5** and **6** which are joined to each other, for example, by stitching, sealing, heat-sealing, etc." (Dereume col. 5, ll. 32-34.) In discussing the production of the intraluminal prosthesis, Dereume teaches that a cylindrical sleeve is formed, which undergoes a leaktight joining, such as by seams, heat sealing, or cold sealing, to form two axial channels over at least part of the length of sleeve (col. 8, ll. 9-29). The sleeve may then be attached to the inner surface of the tubular stent (col. 8, ll. 30-32).

It thus appears that portions (**5**) and (**6**) of sleeve (**4**) as seen in Figure 7, or the partitions in Figures 10, 12, and 17, is merely the leaktight joining discussed above, and the Examiner has not provided any rationale or evidence demonstrating why that would read on the compressible gasket required by claim 1. Thus, the Examiner has failed to establish a prima facie case of obviousness, and we are compelled to reverse the rejection. *KSR Int'l Co., v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (noting that, in order to facilitate review of the obviousness determination, the "analysis should be made explicit").

CONCLUSION

In summary, we affirm the rejection of claims 1, 6, 21, and 24 under 35 U.S.C. §102(b) as being anticipated by Rhodes, and the rejection of claim 20 under 35 U.S.C. § 103(a) as being rendered obvious by Rhodes. But, as the Examiner failed to set forth a prima facie case of obviousness based on the combination of Dereume and Lunn, we are compelled to reverse the § 103(a) rejection of claims 1, 6, 20, 21, and 24.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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